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10/692,976	10/24/2003	David E. Stern	02,104-A	1707
33097 7590 02/03/2009 LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603				
EXAMINER NGUYEN, TRAN N				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,976

**Applicant(s)**

STERN ET AL.

**Examiner**

Tran Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/US)  
Paper No(s)/Mail Date 12/22/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

This communication is in response to the communication filed 12/22/2004.

Pending claim(s): 1-35.

***Priority***

Acknowledgment is made of Applicant's claim for priority to application 60422083 filed 10/29/2002.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 12/22/2004 is entered and considered by Examiner.

***Specification***

Examiner notes the use of terminology that may potentially considered to be trademarks in this application. Trademarks should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Applicant is requested to verify the proprietary terms to determine if they are trademarked, and respond accordingly.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 3-14, 15, 17-20, 22-28, 30-32, 34-35 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski* et al, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Claim 1 recites a method comprising receiving on a server computer; however, the remaining steps do not require the particulars of a machine. Therefore, the essential data processing steps of the method do not limit the claim to a particular machine.

Additionally, the claim produces mere data transformation at best, and do not produce a physical transformation.

Therefore, claim 1 is found to be directed towards nonstatutory subject matter.

As per claims 2, 16, 21, 29, these claims are found to be directed towards statutory subject matter because a computer readable medium has been positively recited.

As per claims 3-14, these claims fail to remedy the deficiencies of parent claim 1, and are therefore rejected for at least the same rationale as applied to claim 1 above, and incorporated herein.

As per claims 15, 17-20, 22-28, 30-32, these claims are rejected for substantially the same rationale as applied to claims 1, 3-14 above, and incorporated herein.

As per claim 33, this claim recites a system comprising a plurality of structural limitations.

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First, "paper medical information templates" amount to abstract data captured by a piece of paper. A piece of paper has not positively recited. Therefore, this limitation does not amount to a physical structure.

Second, "electronic medical information templates" are clearly software *per se* limitations.

Third, "application", "engine", and "interface" may be reasonably interpreted to envelop software *per se*.

Therefore, the entire claim is directed to abstract data and software *per se* at best.

All claims dependent thereon, namely claims 34-35, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 20-24, 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Dart (6529876).

As per claim 20, Dart teaches a method (Abstract) capable of processing billing code for care rendered by health care providers (reads on "medical information") (Abstract), comprising:

(a) providing a health care provider (column 10 line 36) secure communication with a server over a network (column 10 line 47-50), wherein the health care provider is capable of inputting into the computer a code selecting an electronic template specific to a type of patient encounter as well as other data specified by the electronic template (reads on "medical information template from an encounter with a patient") (column 11 line 22-28);

(b) determining the electronic template data inputted by the physician (column 11 line 22-24) (reads on "processing the one or more digital images to extract patient encounter information included in the digital images" when viewed in combination with Newman as discussed above);

(c) generating a Final E&M code (reads on "one or more medical codes") from the inputted data (column 11 line 31);

(d) using the Final E&M code for billing purposes (reads on "one or more electronic templates") (column 11 line 32) in realtime (column 11 line 5), wherein the billing purposes comprises forwarding for reimbursement (reads on "a

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graphical user interface") and satisfying an inquiry by an agency (reads on "additional medical information documents") (column 11 line 5-8).

As per claim 21, Dart teaches a program (Abstract) embedded in a computer system (Figure 12) capable of performing the recited method.

As per claim 22, Dart teaches:

(a) generating billing documents from the generated code and forwarding the generated billing documents for reimbursement (reads on "a fee") in realtime (column 11 line 5-8);

(b) using the billing document (It is noted that any data processing is inherently performed in "real-time" because the actual data is processed. Examiner considers this limitation to recite that "utilizing" is performed in "real-time". Therefore, any data processing using the recited data will be performed in real-time) (column 11 line 5-8).

Examiner considers the billing system to be a GUI or "another data processing system".

As per claim 23, this claim is rejected for substantially the same rationale as applied to claim 3 above, and incorporated herein.

In particular, an "invoice" is considered to be a "medical record" because the invoice contains therein medical data.



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Additionally, Dart further teaches providing the data in realtime to satisfy an inquiry of an agency (also reads on "medical record") (column 11 line 7-8).

As per claim 24, Dart teaches E&M coding (column 1 line 58).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 27, Dart teaches using the generated code for billing purposes (reads on "an electronic invoice template") (column 3 line 8-12).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1-11, 14-19, 28-32 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Newman (A desk supporting computer-based interaction with paper documents).

As per claim 1, Dart teaches a method (Abstract) capable of processing billing code for care rendered by health care providers (reads on "medical information") (Abstract), comprising:

(a) providing a health care provider (column 10 line 36) secure communication with a server over a network (column 10 line 47-50), wherein the health care provider is capable of inputting into the computer a code selecting an electronic template specific to a type of patient encounter as well as other data specified by the electronic template (reads on "medical information template from an encounter with a patient") (column 11 line 22-28).

Dart further teaches a physician interacting with a computer (Figure 12 label 1850). Dart further teaches that data may be entered in any manner, and not necessarily via one of the disclosed computer interfaces (column 9 line 50-52).

Dart does not teach "one or more digital images created from a paper".

Newman teaches using gesture recognition and text/numbers printed on a paper document to enter data into a computer (page 590 Figure 3).

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Specifically, Newman teaches that the physical paper document and human gesture are recorded by a camera (reads on "one or more digital images") and translated to computer input (page 589 Figure 2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Newman within the embodiment of Dart with the motivation of providing users with the ability to enter data into a computer using intuitive techniques (Dart; page 587-588, Introduction and Motivation).

Dart further teaches:

(b) determining the electronic template data inputted by the physician (column 11 line 22-24) (reads on "processing the one or more digital images to extract patient encounter information included in the digital images" when viewed in combination with Newman as discussed above);

(c) generating a Final E&M code (reads on "one or more medical codes") from the inputted data (column 11 line 31);

(d) using the Final E&M code for billing purposes (reads on "one or more electronic templates") (column 11 line 32) in realtime (column 11 line 5), wherein the billing purposes comprises forwarding for reimbursement (reads on "a graphical user interface") and satisfying an inquiry by an agency (reads on "additional medical information documents") (column 11 line 5-8).

Should Applicant argue that claim 1 patentably distinguishes from the prior art via the paper template, Applicant is warned that this argument would establish claim 20 as a separately patentable invention because claim 20 recites electronic

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template. As such, the *prima facie* evidence suggest that the method of inputting data into the computer, paper or electronic, is not material to the remaining data processing steps, and amounts to design choice of previously known data entry techniques at best.

As per claim 2, Dart teaches a program (Abstract) embedded in a computer system (Figure 12) capable of performing the recited method.

As per claim 3, Dart teaches:

(a) generating billing documents from the generated code and forwarding the generated billing documents for reimbursement (reads on "a fee") in realtime (column 11 line 5-8);

(b) using the billing document (It is noted that any data processing is inherently performed in "real-time" because the actual data is processed. Examiner considers this limitation to recite that "utilizing" is performed in "real-time". Therefore, any data processing using the recited data will be performed in real-time) (column 11 line 5-8).

As per claim 4, this claim is rejected for substantially the same rationale as applied to claim 3 above, and incorporated herein.

In particular, an "invoice" is considered to be a "medical record" because the invoice contains therein medical data.

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Additionally, Dart further teaches providing the data in realtime to satisfy an inquiry of an agency (also reads on "medical record") (column 11 line 7-8).

As per claim 5, Dart teaches E&M coding (column 1 line 58).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 6, Dart teaches collecting from the inputted data (column 4 line 1-19):

- (a) patient history (column 2 line 35);
- (b) examination data (reads on "physical examination information complexity information") (column 2 line 35);
- (c) patient data (reads on "status information" and "demographic information") (column 2 line 35-45);
- (d) diagnosis information (column 2 line 40);
- (e) treatment information (column 2 line 40-41);
- (f) lab tests (reads on "supply information" because lab tests inherently uses some "supply") (column 4 line 11).

First, the recited data amount to nonfunctional descriptive material at best because Applicant has not positively recited how each type of data functionally affects the outcome of the claimed method. Therefore, at best, Applicant has relabeled the data described in the prior art. To properly overcome this rejection, Applicant is suggested to positively recite what each piece of data is, and how

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the composition of each data materially and functionally affects the outcome of the method.

Absent this positive recitation, any data would be *prima facie* obvious of the claimed data because the claimed data imparts no functionality on the claimed method. Additional guidance is available at:

<http://www.uspto.gov/web/menu/pbmethod/>

Second, Applicant is requested to discuss the usage of the recited data in the prior art in known automated or manual processes. Did Applicant invent using, for example, historical information to determine a billing code, or does Applicant only claim using a known process in application to Applicant's automated system?

Applicant is cautioned that ample evidence exists in the prior art regarding usage of historical data to determine billing code, including HCFA published guidelines.

Applicant's assistance is requested to clearly set forth what Applicant allegedly invented.

As per claim 7, Dart teaches generating billing codes and using these codes to bill for professional services (column 1 line 1-19).

As per claim 8, Dart teaches realtime audit performed by the physician at the time of data entry (column 9 line 43-50).

When read in combination with Newman, the prior art suggest "verifying... information included in the digital images" because Newman also teaches that the computer verifies the physical user input, and is considered to be machine verification (page 589 Figure 2).

As per claim 9, Dart teaches using check boxes to obtain data (column 3 line 5).

When read in combination with Newman, the prior art suggest entering data manually with check boxes printed on a paper document instead of computerized check boxes as taught by Dart.

As per claim 10, Dart teaches using the generated code for billing purposes (reads on "an electronic invoice template") (column 3 line 8-12).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 11, Dart teaches determining new and established (reads on "existing") patients (column 2 line 15-17).

As per claim 14, Dart teaches auditing the generated E&M coding prior to billing (Abstract). Dart further teaches comparing the entered data with the generated E&M coding for auditing purposes (column 3 line 35-47).

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When read in combination with Newman, the prior art suggest storing user inputted data for auditing.

As per claim 15, this claim is rejected for substantially the same rationale as jointly applied to claims 1, 6-7 above, and incorporated herein.

As per the set of claim(s): 16, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 2, respectively, and incorporated herein.

As per claim 17, this claim rejected for substantially the same rationale as applied to claim 15 above, and incorporated herein.

In particular, "value" has been given its broadest interpretation in view of the specification and the level of ordinary skill in the art at the time the invention was made. Accordingly, a "value" is considered to be any indication of the recited information, and is taught by the prior art.

Should Applicant disagrees with this interpretation of "value", Applicant is requested to provide a controlling definition for "value" with evidentiary support from the specification as originally filed or from the level of ordinary skill in the art as was known at the time of filing.



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As per the set of claim(s): 18, 19, 28, 29, 30, 31, 32, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 8, 5, 1, 2, 5, 10, 17, respectively, and incorporated herein.

Claim(s) 12-13 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Newman as applied to parent claim 1 above, and further in view of Evans (5924074) and Official Notice.

As per claims 12-13, Dart and Newman jointly teach the use of manual/automated hybrid interfaces to input data into a computer system, as discussed above and incorporated herein.

Dart and Newman do not teach "an audio provider dictation... on an electronic medical record", including generating a plurality of electronic text therefrom.

Evans teaches recording audio dictation in a patient's medical record (column 9 line 3-4). Evans also suggests storing text data (Figure 14 label 223).

Official Notice is taken that it is old and well established to transcribe physician dictations into text and storing the transcribed text as part of the patient's medical record in the art of health care management.

All component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Evans and Official Notice within

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the embodiment of Dart and Newman, since the operation of the medical transcription is in no way dependent on the billing code generator, and a standard medical record management system such as Evans may be used with a billing computer to achieve the predictable result of providing a multi-purpose computer.

If Applicant disagrees with the noticed facts, Applicant is requested to discuss why it is not known for physicians to provide voice dictations for text transcriptions to be entered into the patient's medical record. Such assertion would amount to a claim by Applicant that Applicant invented this feature that has been in use for many years by physicians.

Claim(s) 25-26 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Evans and Official Notice.

As per the set of claim(s): 25, 26, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 12, 13, respectively, and incorporated herein.

Claim(s) 33-35 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dart in view of Newman, Evans, and Official Notice.

As per claim 33, this claim is rejected for substantially the same rationale as jointly applied to claims 1, 9, 12-13 above, and incorporated herein.

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In particular, Examiner considers "associating the transcribed electronic information with one or more electronic templates created for the patient encounters" to recite storing the transcribed text into the patient's medical records.

As per the set of claim(s): 34, 35, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 5, 10, respectively, and incorporated herein.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3626

01/31/2008

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626